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| EXAMINER | | | | |
| VIG, NARESH | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/713,301

Applicant(s)

MITSUHASHI ET AL.

Examiner

NARESH VIG

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-25 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1 – 5 and 14, drawn to a method for providing an electric bulletin board that enables to stores the image and remarks provided by the user. A third party judges the user provided images to judge whether or not the image is permitted when a browsing of the image provided for the electric album service is demanded; said third party either permits or bans the browsing of the image in the bulletin board. User is provided with a display screen comprising link portion to access the electronic bulletin board wherein a contracted image of the image stored onto the memory area provided for the electric album service is displayed in the bulletin board, and the original image is read out from the memory area provide for the electric album service and displayed in the bulletin board when the link portion is clicked on, and allows a user to erase the image from the electric album service, classified in class 705, subclass 1.
- II. Claims 6 – 13 and 15 – 20, drawn to a method for providing an electric bulletin board that works with an electric album service providing a storage area of an image to a user and that enables to carry an image along with remarks and so sent respectively by a plurality of users; carry an image based upon the image stored onto the storage area provided for the

electric album service in the bulletin board when the image stored onto the area provided for the electric album service is demanded to be carried in the bulletin board; display an image for a browsing when the image stored onto the area provided for the electric album service is demanded to be browsed through a link portion in the bulletin board; and save the image for the electric bulletin board, even when the image stored onto the area provided for the electric album service is erased. A second image of lower resolution to be carried in the bulletin board is created from the original image stored onto a memory area provided for the electric album service wherein the second image data is stored onto the storage area different from first image data. A third image with resolution higher than the second image is created from the first image is created. When there is no access to an electric album for more than a given period of time by a user having recorded image data, image data recorded onto the data storage area is erased, classified in class 705, subclass 1.

- III. Claim 21, drawn to a method for providing an electric album service by recording registration information including at least authentication information about an electric album user sent from the electric album user; store image data sent from the electric album user onto a data storage area; read out image data in response to the authentication information sent from the electric album user; transmit this data to the electric album user; record management information that classifies image data into a

given group; read out image data per the given group by use of management information; and transmit this data to a manager of the electric album, classified in class 705, subclass 1.

- IV. Claim 22, drawn to a method for providing an electric album service comprising by recording registration information including at least authentication information about an electric album user sent from the electric album user; store image data sent from the electric album user onto a data storage area; read out image data from the data storage area of the electric album user when authentication information agrees with recorded authentication information; transmit this data to the electric album user; read out image data sequentially; extract shooting information included in each of image data sequentially; and transmit extracted shooting information to a manager of the electric album, classified in class 705, subclass 1.
- V. Claim 23, drawn to A method for providing an electric album service by recording registration information including at least authentication information of an electric album user sent from the electric album user; give a random name different from those of other image data to image data sent from the electric album user; record image data with the given name onto a data storage area; read out image data from the data storage area of the electric album user when authentication information agrees

with recorded authentication information; and transmit image data to the electric album user, classified in class 705, subclass 1.

- VI. Claim 24, drawn to a method for providing an electric album service by recording image data sent from an electric album user onto a data storage area; provide image data for a browse on demand for a browse during a predetermined period of time; detect whether or not an electric album user purchasing a product has already completed a customer registration of the product; and extend a predetermined usable period of time of the electric album when the customer registration has been completed, classified in class 705, subclass 1.
- VII. Claim 25, drawn to method for providing an electric album service by recording image data sent from an electric album user onto a data storage area of a predetermined capacity; provide image data for a browse on demand for a browse; detect whether or not an electric album user purchasing a product has already completed a customer registration of the product; and enlarge a capacity of the data storage area when the customer registration has been completed, classified in class 705, subclass 1.

The inventions are distinct, each from the other because of the following reasons:

Inventions I – VII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case,

subcombination I has separate utility such as a third party judges the user provided images to judge whether or not the image is permitted when a browsing of the image provided for the electric album service is demanded; User is provided with a display screen comprising link portion to access the electronic bulletin board wherein a contracted image of the image stored onto the memory area provided for the electric album service is displayed in the bulletin board, and the original image is displayed in the bulletin board when the link portion is clicked on;

subcombination II has separate utility such as saving of the image for the electric bulletin board, even when the image stored onto the area provided for the electric album service is erased; A second image of lower resolution is created from the original image stored onto a memory; a third image with resolution higher than the second image is created from the first image is created; when there is no access to an electric album for more than a given period of time by a user having recorded image data, image data recorded onto the data storage area is erased.

subcombination III has separate utility such as record management information that classifies image data into a given group; read out image data per the given group

by use of management information; and transmit this data to a manager of the electric album.

subcombination IV has separate utility such as read out image data from the data storage area of the electric album user when authentication information agrees with recorded authentication information; read out image data sequentially; extract shooting information included in each of image data sequentially; and transmit extracted shooting information to a manager of the electric album.

subcombination V has separate utility such as giving a random name different from those of other image data to image data sent from the electric album user; record image data with the given name onto a data storage area;

subcombination VI has separate utility such as detecting whether or not an electric album user purchasing a product has already completed a customer registration of the product; and extend a predetermined usable period of time of the electric album when the customer registration has been completed.

subcombination VII has separate utility such as recording image data sent from an electric album user onto a data storage area of a predetermined capacity; detect whether or not an electric album user purchasing a product has already completed a customer registration of the product; and enlarge a capacity of the data storage area when the customer registration has been completed.

See MPEP § 806.05(d).

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected invention.**

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election

shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

A telephone interview was not conducted due to complexity of the restriction requirement and since the examiner knows from past experience that an election will not be made by telephone. (see MPEP 812.01).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NARESH VIG whose telephone number is (571)272-6810. The examiner can normally be reached on Mon-Thu 7:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

September 21, 2008

/Naresh Vig/
Primary Examiner, Art Unit 3629